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**AUG 22 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Richard L. Giroux et al. :  
Application No. 10/772,217 : DECISION ON PETITION  
Filing Date: February 2, 2004 : UNDER 37 C.F.R. §1.78(a)(3)  
Attorney Docket No.: WEAT/0344 :  
Title: APPARATUS AND METHODS :  
FOR DRILLING A WELLBORE USING :  
CASING :

This is a decision on the petition under 37 C.F.R. § 1.78(a)(3) filed May 22, 2006, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of nonprovisional application number 10/331,964, filed December 30, 2002, which issued as U.S. Patent number 6,857,487 on February 22, 2005, as set forth in the concurrently filed amendment.

The petition is DISMISSED.

A petition for acceptance of a claim for late priority under 37 C.F.R. 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 C.F.R. 1.78(a)(2)(ii). In addition, the petition under 37 C.F.R. 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 C.F.R. §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and

- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference to add the above-noted, prior-filed application on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 C.F.R. § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 C.F.R. 1.121 and 37 C.F.R. 1.76(b)(5)) to correct the above matters are required.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail<sup>1</sup>, hand-delivery<sup>2</sup>, or facsimile<sup>3</sup>.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225<sup>4</sup>. All other inquiries

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1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.

4 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for

concerning examination procedures or status of the application should be directed to the Technology Center.

A handwritten signature in cursive script, appearing to read "Frances Hicks".

Frances Hicks

Petitions Examiner

Office of Petitions

United States Patent and Trademark Office

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Petitioner's further action(s).